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RESPONSE under 37 C.F.R. § 1.111  
U.S. Appln. No. 10/712,792**REMARKS:**

By this amendment, Applicant cancels claim 6, 12-13 and 15-16 without prejudice or disclaimer and adds new claims 18-22. Thus claims 1-5, 7-11, 14 and 17-22 are all the claims pending in the present application. All previously pending claims stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

**RESTRICTION.**

Applicant hereby confirms the provisional election made on August 1, 2006, electing the generic and calculator species relating to claims 1, 2, 6 (now cancelled) and 7-17. Applicant does not traverse the requirement. Applicant does not however cancel claims 3, 4 and 5, which are presently withdrawn from consideration, as they are believed to depend from an allowable generic claim.

**INFORMATION DISCLOSURE.**

Applicant submits herewith, an information disclosure statement identifying the references outlined in the specification and others, for consideration by the Office.

**OBJECTIONS.****Specification**

The Office Action objects to the specification due to the reference to trademarks. By this amendment, Applicant addresses the Office Action concerns and reconsideration of this objection is respectfully request in light thereof.

**Drawings**

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appln. No. 10/712,792

The Office Action objects to the drawings under 37 C.F.R. 1.83(a) as not showing all the features specified in the claims. By this amendment, Applicant has cancelled the features not illustrated in the drawing and requests reconsideration in light thereof.

**CLAIM OBJECTIONS.**

The Office Action objects to claim 7 as including informalities. By this amendment, Applicant addresses the objection and respectfully requests reconsideration.

**CLAIM REJECTIONS.**

**35 U.S.C. § 112**

Claim 16 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for using a trademark to define the invention. By this amendment, Applicant cancels claim 16 and thus the rejection is now moot.

**35 U.S.C. § 102**

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,180,133 to Chang. Applicant respectfully traverses this rejection claims, for the following reasons.

It is well established that a claim is only anticipated under 35 U.S.C. § 102 if each and every feature as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In the instant case, the Office Action alleges the clip board of Chang Fig. 4 discloses all of the elements of Applicant's claims 1 and 2. Applicant respectfully disagrees. Applicant's claim 1 recites:

*A personal article holder comprising:  
a clamping body having a clamping position and an open position and  
comprising an upper arm; a lower arm pivotally connected at one end thereof, to a*

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appl. No. 10/712,792

*corresponding end of the upper arm such that personal articles may be retained between the upper and lower arm, said clamping body also having a cavity formed therein; attachment means connected to the clamping body for attaching the clamping body to a desired surface; and*

*a tool operative to be removably inserted into said cavity.*

Respectfully, the device disclosed by Chang is not a personal article holder for holding personal articles, it is a clip board which holds paper. For this reason alone the disclosure of Chang cannot anticipate Applicant's claimed invention. Furthermore, the Office Action alleges that Chang board 20 is analogous to Applicant's claimed *lower arm*. Respectfully, board 20 is not an arm, it is a board. (Chang col. 2, ll. 41-44). Applicant respectfully submits that the Office Action is interpreting Applicant's claims with undue breath and in a manner which is inconsistent with the disclosure of Applicant's specification. The Office is required to interpret claims using the broadest *reasonable* interpretation which must be consistent with the interpretation that those skilled in the art would give. *In re Cortright*, 165 F.3d 1353,1359 (Fed. Cir. 1999). Such interpretation must also be consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). Because Chang discloses a clip board, instead of a personal article holder including clamping body having upper and lower arms, Chang does not anticipate Applicant's claims under 35 U.S.C. § 102.

Notwithstanding the foregoing, in an attempt to advance the prosecution of this application, Applicant amends independent claim 1 to include the limitations regarding *cushion members* from previous claim 6 to more clearly define Applicant's claimed personal article holder. Since Chang clearly fails to disclose or suggest any cushion members, there is no *prima facie* anticipation and reconsideration and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103

1.) Claims 1-2 and 6-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 6,728,995 to Ainley et al. (hereinafter "Ainley") in view of Chang and/or in further view of additional secondary references including U.S. 6,178,085 to Lueng, U.S. 5,653,414 to

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appln. No. 10/712,792

Chimmel, U.S. 6,260,749 to Horovitz, U.S. Appln. 2002/0010983 to Lee, and/or U.S. 5,312,029 to Tuber. Applicant respectfully traverses these rejections for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In the instant rejections, the Office Action relies on Ainley to disclose the majority of Applicant's independent claim limitations (e.g., claims 1, 9 and 17) with the exception of *a tool operative to be removeably inserted into a cavity*. The Office Action relies solely on Chang to make up for this notable deficiency alleging "[i]t would have been obvious to a person having ordinary skill in the art.... to configure the recess of Ainley et al. in such a manner to be able to removably insert Chang's calculator in order to provide a convenient mounting surface for the calculator." Applicant respectfully disagrees and submits that there is no proper motivation for combining/modifying Ainley with Chang as suggested as suggested in the Office Action and thus all rejections based thereon are improper and should be withdrawn.

#### NO PROPER MOTIVATION TO COMBINE/MODIFY AINLEY AND CHANG

The Office Action alleges it would be obvious for the skilled artisan to modify Ainley with the calculator of Chang "in order to provide a convenient mounting surface for the calculator." (8/17/06 Office Action pg. 8) However, Applicant would note that the alleged motivation to combine references is fundamentally flawed. First, since Chang already discloses "a convenient mounting surface for the calculator" the motivation suggested in the Office Action is entirely lacking any reason whatsoever as to why the skilled artisan would bother to modify the Spectacles Caddy 10 disclosed by Ainley with the clipboard including calculator disclosed by Chang.

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appl. No. 10/712,792

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id. at 682*.

Because the Office Action has not set forth any objective reasoning at all why the skilled artisan would combine Ainley and Chang, the Office Action has failed to even allege a proper case of *prima facie* obviousness. Thus the rejection of Applicant's claims based on the combination of Ainley and Chang is insufficient on its face.

Additionally, Applicant respectfully submits there is in fact no proper motivation why the skilled artisan would combine/modify Ainley with Chang. Ainley indisputably discloses a caddy designed solely for holding various types of spectacles. (Col. 1, ll. 1-5; 19-22; 36-37, etc.). By way of contrast, Chang discloses a clip board for holding paper. Since neither cited reference discloses or suggests that the embodiments/principles of their respective inventions could even be applied to other types of goods, there is no motivation present in the references themselves to support combining/modifying in the manner suggested by the Office Action. To this end, it is apparent to the skilled artisan that a calculator could be useful in combination with a writing surface which holds paper such as the clip board disclosed by Chang. However, there doesn't appear to be any reason of record why the skilled artisan would even want to include a calculator with a spectacle caddy of Ainley.

Lastly, the Office Action alleges that Ainley discloses a cavity formed in the clamping body which could be modified to hold the calculator of Chang (8/17/06 Office Action pg. 7). However, after careful review of this reference, Applicant is unable to determine any reference or mention by Ainley regarding this alleged "cavity." Thus Applicant can only assume the slight circular recess shown in the figures of Ainley and referenced by the Office Action does not serve any utilitarian purpose and therefore is merely an ornamental feature without any purpose. Accordingly, the Office Action proposal fit the calculator of Chang into the alleged "cavity" of

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appl. No. 10/712,792

Ainley appears to be derived solely in an attempt to reconstruct the limitations of Applicant's claims in piece meal fashion using Applicant's disclosure as a guide. Such impermissible hindsight can never establish *prima facie* obviousness. MPEP 2143.

Because the proposed motivation for combining/modifying Ainley and Chang is not present in either of the cited references, and because no objective reasoning for combining these references has even been alleged, Applicant submits that *prima facie* obviousness has not been established. The remaining secondary references, to the extent they are not overcome by virtue of Applicant's cancellation of claims discussed above, are not addressed since deficiencies of the Ainley and Chang combination render these rejections moot.

For all the foregoing reasons, Applicant respectfully submits all the pending claims are patentable over the cited art of record and requests reconsideration and withdrawal of all the §103 rejections based on the improper combination of Ainley and Chang.

2.) Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of U.S. Patent 6,178,085 to Leung. Applicant respectfully traverses this rejection for the following reasons.

Without acquiescing to the properness of combining these references, the combination of Chang and Leung fail to teach or suggest the limitation of "a cushion member disposed on opposing surfaces of each of the upper and lower arms, wherein the cushion members are operative to secure a personal article there between when the upper and lower arms are in the clamped position" which is present in claim 8 by virtue of its dependency on claim 1. Accordingly, there is no *prima facie* obviousness and Applicant respectfully requests reconsideration and withdrawal of this rejection.

#### **NEW CLAIMS.**

By this amendment, Applicant adds new claims 18-22 and respectfully requests examination and favorable consideration thereof. New claims 18-22 are part of the elected

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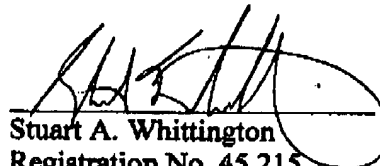
RESPONSE under 37 C.F.R. § 1.111  
U.S. Appln. No. 10/712,792

species (either generically or explicitly) and do not include any new matter. The new claims are similar to existing claims except for claim 19 which finds direct support at paragraph [0027] and claims 20-21 derived from paragraph [0028].

**CONCLUSION.**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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